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Paper No.

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OFFICE OF PETITIONS

In re Application of	:	
Urbain Alfred von der Embse	:	
Application No. 09/846,410	:	DECISION ON PETITION
Filed: February 13, 2001	:	PURSUANT TO
Title: MULTIPLE DATA RATE	:	37 C.F.R. § 3.81(B)
COMPLEX WALSH CODES FOR CDMA	:	

This is a decision on the petition pursuant to 37 C.F.R. § 3.81(b)¹, filed December 17, 2007, to correct the Assignee's information on the Issue Fee Transmittal Form PTOL-85(b).

Petitioner states that due a typographical error appears on form PTOL-85(b), the assignee's name was not listed thereon.

37 C.F.R. § 3.81(b), effective June 25, 2004, reads:

(b) After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in 3.11 before issuance of the patent, and must include a request for a certificate of correction under 1.323 of this chapter (accompanied by the fee set forth in 1.20(a)) and the processing fee set forth in 1.17(i) of this chapter.

¹ See Official Gazette, June 22, 2004.

MPEP §§ 301(I) and (II) sets forth, *in toto*:

I. OWNERSHIP

Ownership of a patent gives the patent owner the right to exclude others from making, using, offering for sale, selling, or importing into the United States the invention claimed in the patent. 35 U.S.C. 154(a)(1). Ownership of the patent does not furnish the owner with the right to make, use, offer for sale, sell, or import the claimed invention because there may be other legal considerations precluding same (e.g., existence of another patent owner with a dominant patent, failure to obtain FDA approval of the patented invention, an injunction by a court against making the product of the invention, or a national security related issue).

The ownership of the patent (or the application for the patent) initially vests in the named inventors of the invention of the patent. See *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248, 26 USPQ2d 1572, 1582 (Fed. Cir. 1993). The patent (or patent application) is then assignable by an instrument in writing, and the assignment of the patent, or patent application, transfers to the assignee(s) an alienable (transferable) ownership interest in the patent or application. 35 U.S.C. 261.

II. ASSIGNMENT

"Assignment," in general, is the act of transferring to another the ownership of one's property, i.e., the interest and rights to the property. In 37 CFR 3.1, assignment of patent rights is defined as "a transfer by a party of all or part of its right, title and interest in a patent or patent application...." An assignment of a patent, or patent application, is the transfer to another of a party's entire ownership interest or a percentage of that party's ownership interest in the patent or application. In order for an assignment to take place, the transfer to another must include the entirety of the bundle of rights that is associated with the ownership interest, i.e., all of the bundle of rights that are inherent in the right, title and interest in the patent or patent application.

The present request pursuant to 37 C.F.R. § 3.81(b) has been accompanied by the petition fee and a copy of form PTOL-85b.

Petitioner has not included a certificate of correction or the \$100 fee associated with the filing of a request for the same.

Moreover, it is noted that Petitioner is the sole inventor, and that he has attempted to add himself as the assignee.

MPEP § 301(I) sets forth that the ownership of the patent (or the application for the patent) initially vests in the named inventor of the invention of the patent. MPEP § 301(II) indicates that assignment is the act of transferring to another the ownership of one's property. As such, Petitioner has attempted to transfer

the ownership of this patent from himself, to himself, and this is not possible.

Hence, this petition must be **DISMISSED**.

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225². All other inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.